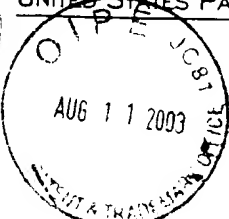




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Paper No. 17

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OFFICE OF PETITIONS
ON PETITION

In re Application of
Victor J. Dzau et al
Application No. 09/839,752
Filed: April 19, 2001
Attorney Docket No. 50025/003002

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 28, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of two prior-filed nonprovisional applications.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR 1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed nonprovisional applications.

The instant pending nonprovisional application was filed on April 19, 2001, and was pending at the time of filing of the instant petition. While a reference to the prior-filed nonprovisional applications was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2). However, on the other hand, if the USPTO does not note the claim for priority to the nonprovisional application in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3).¹

In the instant case, the Office noted the claim for priority of the nonprovisional applications in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the \$1,300 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

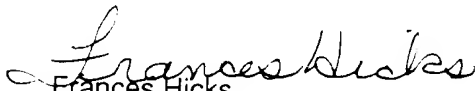
There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application,

¹ Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001, and MPEP 201.11 at page 200-75.

the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

Any questions concerning this decision on petition may be directed to Karen Creasy at (703)305-8859. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center AU 1636 for processing the amendment embodied in the petition of May 28, 2003, and for consideration by the examiner of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) for the benefit of the prior-filed nonprovisional applications.


Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

HELLER EHRMAN WHITE & MCAULIFFE LLP
275 MIDDLEFIELD ROAD
MENLO PARK CA 94025

AUG 11 2003

PTO/SB/30 (5 2000)

Approved for Use through xx/xx/xxxx. OMB 0651-0031
U.S. Patent and Trademark office: U.S. DEPARTMENT OF COMMERCE



1636

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Subsection (b) of 35 U.S.C. §132, effective on May 29, 2000, provides for continued examination of a utility or plant application filed on or after June 8, 1995.
See the American Inventors Protection Act of 1999 (AIPA).

Application Number	09/875,305
Filing Date	June 5, 2001
First Named Inventor	Victor J. Dzau, et al.
Group Art Unit	1636
Examiner Name	Marvich, Maria
Attorney Docket Number	39753-0021C3

This is a Request for Continued Examination (RCE) under 37 C.F.R. §1.114 of the above-identified application.

NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. s 1.53(d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 20000), which established RCE practice.

1. Submission required under 37 C.F.R. §1.114.

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. §1.116 previously filed on
(Any unentered amendment(s) referred to above will be entered)
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
- iii. ☐ Other
- b. ☒ Enclosed
 - i. ☒ Preliminary Amendment and Response
 - ii. ☐ Affidavit(s)/Declaration(s)
 - iii. ☒ Information Disclosure Statement (IDS)/1449 with 43 cited references.
 - iv. ☐ Other

2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☒ Other Copy of decision for Petition Under 37 CFR 1.78(a)(3), filed May 28, 2003

3. Fees

The RCE fee under 37 C.F.R. §1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments to Deposit Account No. 08-1641 (Docket No. 39753-0021C3).
 - i. ☒ RCE fee required under 37 C.F.R. § 1.17(e) (\$375.00)
 - ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
 - iii. ☐ Other
- b. ☐ Check in the amount of \$ _____ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Ginger R. Dreger	Registration No. (Attorney/Agent)	33,055
Signature		Date	August 11, 2003

CERTIFICATE OF MAILING BY EXPRESS MAIL

CERTIFICATE OF MAILING BY "EXPRESS MAIL" - Rule 10: I hereby certify that this correspondence is being deposited on August 11, 2003 with the U.S. Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. 1.10 as Express Mail No. **EV346725809US** addressed to: Mail Stop: RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name (Print/Type)	Cheryl Ann Rogers
Signature	
Date	August 11, 2003



Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND Fees and Completed Forms to the following address: Mail Stop ____, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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